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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of Andreas Sasse Serial No. 09/600,458 Filed: August 14, 2000 Title: METHOD FOR TERMINAL ASSISTED MENU PRESENTATION OF ADDED VALUE SERVICES IN MOBILE COMMUNICATION SYSTEMS) Confirmation No.: 3399
) Group: 2684
) Examiner: Sujatha R. Sharma
) Attorney Docket No.: RBL0064-02
) Customer No.: 00832

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Assistant Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This appeal is taken from the Examiner's decision dated June 30, 2005 in the above-identified patent application, finally rejecting Claims 1-12 and 15, by way of a Notice of Appeal filed on September 27, 2005, which period for filing an Appeal Brief has been extended by the enclosed Petition For Extension Of Time for one (1) month to December 27, 2005.

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I. REAL PARTY IN INTEREST

The real party in interest is T-Mobile Deutschland GmbH, having its principal place of business at Landgrabenweg 151, D-53227 Bonn, Germany, and the assignee of the present application by virtue of an assignment from the inventor recorded on October 23, 2000 at Reel 011197, Frame 0051, after which the assignee name was changed from DeTeMobil Deutsche Telekom MobilNet GmbH to T-Mobile Deutschland GmbH by virtue of an assignment recorded on June 13, 2002 at Reel 012967, Frame 0673.

II. RELATED APPEALS AND INTERFERENCES

Neither the Appellant, the Appellant's representatives, nor the assignee know of any other appeals, interferences, or judicial proceedings which are related to, will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Pending: Claims 1-12 and 15.

Canceled: 13-14 and 16-18.

Withdrawn: None.

Allowed: None.

Objected to: None.

Rejected: Claims 1-12 and 15.

On Appeal: Claims 1-12 and 15.

Claims 1-12 and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over German Patent No. DE 196 10 840 A1 to Eul (hereinafter "Eul '840") in view of U.S. Patent No. 6,317,131 to Basso et al. (hereinafter "Basso et al. '131") and further in view of U.S. Patent No. 6,564,048 to Sugita (hereinafter "Sugita '048"). Claim 8 stands rejected under 35 U.S.C. §

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103(a) as being obvious over Eul '840, Basso et al. '131, and Sugita '048 in view of U.S. Patent No. 6,011,976 to Michaels et al. (hereinafter "Michaels et al. '976").

These rejections are appealed.

IV. STATUS OF AMENDMENTS

Claims 1-12 and 15 have not been amended since the Final Office Action of June 30, 2005. The Notice of Appeal was filed on September 27, 2005. Claims 1-12 and 15 are set forth in the Claims Appendix.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to mobile communication systems, and, more particularly, to a method for terminal assisted menu presentation of value added services in mobile communication systems where the value added services are accessible via value added services nodes where objects are loaded in a mobile station comprising a mobile terminal and a subscriber identity module. A subscriber and a value added services node communicate relative to value added services offered with the objects. The objects may include at least one of executable programs, functions, and data. An object contains at least an abbreviated form of the menu of a value added service. The objects are controlled, modified, or executed via a wireless interface of the mobile communication system. The object verifies the technical capabilities of the mobile station and automatically adapts to the technical capabilities of the mobile station. An object suitable to the technical capabilities of the mobile station is subsequently selected and loaded into the mobile station. The technical capabilities of the mobile station are stored in a special database. The communication between a subscriber and a value added services node includes loading the objects into the mobile station with a short message service. A short message is communicated from the value added services node to the mobile station containing the version number of the object available from the value added services node. The version number of the available object is compared with a version number of the object available in the mobile station and, if a more up-to-date object is available, the more up-to-date object is loaded into the mobile

station. A short message is communicated from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node. The operation is selected by the user of the mobile station.

Referring to Fig. 1, the objects are held in object center 9. An object contains an abbreviated form of the menu of a value added service having a fixed allocation between the keys of mobile station 1 and actions of the value added service. Upon initial contact of a mobile station with value added services (VAS) node 7 via wireless interface 5 of mobile network 4 or via interface of a subscriber identity module card reader from service provider 10, objects are loaded in subscriber identity module (SIM) 3 of mobile station 1 via short message service (SMS) 6 or a General Packet Radio Service (GPRS). The short message contains a version number which is compared with the version number of the object available in mobile station 1 and, if applicable, causes a more up-to-date object to be loaded. If a user selected a menu item via the keyboard and, if this operation has been successfully completed in VAS node 7, then VAS node 7 sends a short message (SM) to SIM 3 whereupon SIM 3 updates the display in mobile station 1. *See, Substitute Specification, Pages 3-4.*

The objects are modified via short messages (SM). This usually takes place in the case of upgrades, *i.e.*, if the menu in VAS node 7 or the menu of an individual VAS has changed, and the object is subsequently adapted accordingly. If required, the object will be erased completely and replaced by a new one. If the objects are to be adapted to the individual capabilities of mobile station 1, the respective profiles of the capabilities are available either in home location register (HLR) 8 of the subscriber or in object center 9. *See, Substitute Specification, Pages 3-4.*

Advantageously, the objects allow a preferably visual menu presentation in the mobile station for the selected value added service making it considerably easier for the subscriber to use it. The loading process is initiated via the wireless interface by the user or by events, such as the initial call from/to a value added services node. The objects are capable of adapting to the capabilities of the mobile station, such as the size of the display, black and white, or color. Such adaptation takes place either via polymorphism or by storing the capabilities of the mobile station in the communication network whereby respectively adapted objects are loaded, when required. Furthermore, modifications of the objects are initiated either explicitly by the user or

implicitly by the object itself, for example for updating a menu structure. *See*, Substitute Specification, Pages 2-3.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Independent Claim 1, and Claims 2-12 and 15, which depend therefrom, respectively, stand rejected under 35 U.S.C. § 103(a) as being obvious over Eul '840 in view of Basso et al. '131 and further in view of Sugita '048.
- B. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being obvious over Eul '840, Basso et al. '131, and Sugita '048 in view of Michaels et al. '976.

VII. ARGUMENT

- A. Independent Claim 1, and Claims 2-12 and 15 depending therefrom, respectively, are not rendered obvious by Eul '840 in view of Basso et al. '131 and further in view of Sugita '048.**

Independent Claim 1 calls for a method for terminal assisted menu presentation of value added services in mobile communication systems where the value added services are accessible via value added services nodes where objects are loaded in a mobile station including a mobile terminal and a subscriber identity module, the method including the steps of communicating between a subscriber and a value added services node relative to value added services offered with the objects, the objects including at least one of executable programs, functions, and data, and wherein an object contains at least an abbreviated form of the menu of a value added service; controlling, modifying, or executing the objects via the wireless interface of the mobile communication system; verifying with the object the technical capabilities of the mobile station and the objects automatically adapting to the technical capabilities of the mobile station; subsequently selecting and loading into the mobile station an object suitable to the technical capabilities of the mobile station, wherein the technical capabilities of the mobile station are stored in a special database; wherein the step of communicating between a subscriber and a value added services node includes loading the objects into the mobile station with a short message

service; communicating a short message from the value added services node to the mobile station containing the version number of the object available from the value added services node; comparing the version number of the available object with a version number of the object available in the mobile station and, if a more up-to-date object is available, loading the more up-to-date object into the mobile station; and communicating a short message from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station.

Appellant respectfully submits that Eul '840 in view of Basso et al. '131 and further in view of Sugita '048 do not disclose or suggest the following steps contained in Claim 1 on appeal:

- verifying with the object the technical capabilities of the mobile station and the objects automatically adapting to the technical capabilities of the mobile station;
- subsequently selecting and loading into the mobile station an object suitable to the technical capabilities of the mobile station, wherein the technical capabilities of the mobile station are stored in a special database;
- communicating a short message from the value added services node to the mobile station containing the version number of the object available from the value added services node;
- comparing the version number of the available object with a version number of the object available in the mobile station and, if a more up-to-date object is available, loading the more up-to-date object into the mobile station;
- communicating a short message from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station.

Eul '840 discloses a procedure to load electronic games for a mobile communication transmitter. The communication transmitter queries about electronic games emitted by a control device, a game is then selected by means of a dialogue controlled by the input device of the communication transmitter, and the data and/or program associated with the game is then transmitted from the control device to the communication transmitter. *See*, Eul '840 translation, Pages 2-3 and 5. The dialogue between the service control unit and mobile communication

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transmitter occurs in a speech channel or short message service of a GSM mobile radio system. *See, Eul '840 translation, Page 13.* The games are offered by the service control unit in the form of a menu or table. *See, Eul '840 translation, Page 14.* Eul '840 fails to disclose or suggest the steps of verifying with the data/game the technical capabilities of the communication transmitter and the data automatically adapting thereto; communicating a short message from the control device to the communication transmitter containing the version number of the available data/game and loading a more up-to-date version if available; and communicating a short message from the control device to a subscriber identity module which updates a display of the communication transmitter upon successful completion of an operation in the control device, the operation selected by the user of the communication transmitter, as called for in Independent Claim 1. Appellant respectfully submits that Basso et al. '131 and Sugita '048 do not cure this deficiency.

Basso et al. '131 discloses a method for reproducing a multi-media signal on a terminal where the multi-media data are displayed based on user preferences and the technical capabilities of the terminal. Sugita '048 discloses a radio communication system wherein the version number of an available piece of information is compared with the version number of the information available in a mobile station and then downloads the more up-to-date information in the mobile station. Nowhere do Basso et al. '131 and Sugita '048 together or alone disclose or suggest verifying the technical capabilities of the mobile station and subsequently selecting and loading into the mobile station an object suitable to the technical capabilities of the mobile station. Furthermore, nowhere do Basso et al. '131 and Sugita '048 together or alone disclose or suggest the steps of communicating a short message from the value added services node to the mobile station containing the version number of the object available from the value added services node and communicating a short message from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station. In contrast, Basso et al. '131 discloses a method for reproducing a data signal based on user preferences and the technical capabilities of the terminal and Sugita '048 discloses a method for downloading more up-to-date information in a mobile station with no suggestion or disclosure of the above-described steps.

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Therefore, in summary, even if Eul '840, Basso et al. '131, and Sugita '048 were combined, all of the method steps of Independent Claim 1 are not present. Specifically, the combination of these three references fails to teach the steps of communicating a short message from the value added services node to the mobile station containing the version number of the object available from the value added services node; and communicating a short message from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station.

Moreover, the Examiner has further failed to establish a *prima facie* case of obviousness because the Examiner has provided no teaching or incentive to combine Eul '840, Basso et al. '131, and Sugita '048.

A person of ordinary skill in the art would not be motivated to combine Basso et al. '131 with either Eul '840 or Sugita '048 because Basso et al. '131 is not in the same field of endeavor. In general, Eul '840 and Sugita '048 disclose mobile communication systems. In contrast, Basso et al. '131 has no disclosure or suggestion of a mobile communication system. In particular, Basso et al. '131 has nothing to do with a terminal assisted menu presentation of value added services in a mobile communication network. In fact, the entire specification and claims of Basso et al. '131 fails to even mention the word "mobile", "communications", or "network." Thus, a person of ordinary skill in the art would never choose Basso et al. '131 to combine with Eul '840 and Sugita '048 to solve problems in the mobile communication network or system field because Basso et al. '131 fails to even mention or discuss a mobile communication system or network. *See, In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992) ("In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."); *see also, In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."). Furthermore, Sugita '048 also does not relate, in particular, to methods for controlling value added services in a mobile communication network.

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Furthermore, Appellant respectfully submits that the Examiner has failed to point out where, in the cited references, there is a motivation or incentive to lead or compel one of ordinary skill in the art to combine the steps of the claimed method. The Examiner has merely pointed out that the references *can* be combined or that it would be obvious to one of ordinary skill in the art to combine the references. To support this point, the Examiner has stated that because all of the references are in the same field of endeavor, then they can be combined. Even if the references *could* be combined and are, *arguendo*, in the same field of endeavor (which they are not, as described above), the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See, In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The Examiner has failed to show where and how the prior art suggests the desirability of the combination. As pointed out above, even if combined the three references fail to disclose all of the steps in the method of Claim 1.

Moreover, statements such as those made by the Examiner that it would be obvious to one of ordinary skill in the art to modify the prior art to meet the claimed invention because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *See, Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). The Examiner has failed to provide any objective reason to combine the teachings of the references. Instead, the Examiner has simply stated advantages of the claimed invention without any objective reasons to combine the teachings of the references. Appellant respectfully submits that this "motivation" stated by the Examiner is simply a recitation of an advantage associated with the current invention and not a teaching or suggestion to combine Eul '840, Basso et al. '131, and Sugita '048. Appellant respectfully submits that the proper inquiry for establishing obviousness under 35 U.S.C. § 103 is not whether the disclosures of multiple references may be advantageously combined, but rather whether the references contain a teaching or suggestion for such a combination. *See, In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Because the combination of Eul '840, Basso et al. '131, and Sugita '048 does not disclose all of the method steps of Independent Claim 1, and because the Examiner has failed to provide a

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motivation or incentive to combine Eul '840, Basso et al. '131, and Sugita '048, Appellant respectfully submits that Claim 1, and Claims 2-12 and 15 dependent thereon, are not rendered obvious by the combination of these three references.

B. Claim 8 is not rendered obvious over Eul '840, Basso et al. '131, and Sugita '048 in view of Michaels et al. '976.

Claim 8, which depends from Claim 1, is not rendered obvious over Eul '840 in view of Basso et al. '131 and Sugita '048, and further in view of Michaels et al. '976 for at least the reasons as set forth above. Michaels et al. '976 discloses downloading data into a subscriber identity module (SIM) card. However, Michaels et al. '976 fails to cure the deficiencies of the combined references, as discussed above. Furthermore, the Examiner has failed to provide a motivation or incentive to combine the disclosure of Michaels et al. '976 with the other three cited references to arrive at the novel method set forth in Claim 8. Therefore, Claim 8 is not rendered obvious over Eul '840 in view of Basso et al. '131 and Sugita '048, and further in view of Michaels et al. '976 because Michaels et al. '976 does not correct for the deficiencies described above and because the Examiner has provided no motivation or incentive to combine these four references.

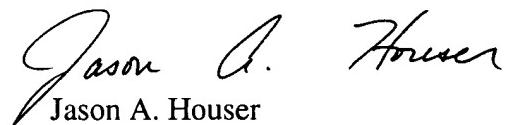
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VIII. CONCLUSION

Appellant respectfully requests reversal of the Examiner's rejections, and allowance of the claims.

Respectfully submitted,


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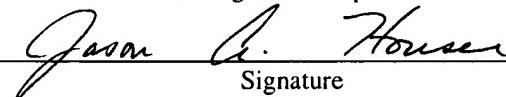
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JASON A. HOUSER, REG. NO. 53,038

Name of Registered Representative


Signature

December 20, 2005

Date

IX. CLAIMS APPENDIX

1. A method for terminal assisted menu presentation of value added services in mobile communication systems where the value added services are accessible via value added services nodes where objects are loaded in a mobile station comprising a mobile terminal and a subscriber identity module, comprising the steps of:

communicating between a subscriber and a value added services node relative to value added services offered with the objects, the objects including at least one of executable programs, functions, and data, and wherein an object contains at least an abbreviated form of the menu of a value added service;

controlling, modifying, or executing the objects via the wireless interface of the mobile communication system;

verifying with the object the technical capabilities of the mobile station and the objects automatically adapting to the technical capabilities of the mobile station;

subsequently selecting and loading into the mobile station an object suitable to the technical capabilities of the mobile station, wherein the technical capabilities of the mobile station are stored in a special database;

wherein the step of communicating between a subscriber and a value added services node includes loading the objects into the mobile station with a short message service;

communicating a short message from the value added services node to the mobile station containing the version number of the object available from the value added services node;

comparing the version number of the available object with a version number of the object available in the mobile station and, if a more up-to-date object is available, loading the more up-to-date object into the mobile station; and

communicating a short message from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station.

2. Method according to claim 1, wherein the objects are loaded in the mobile station via the wireless interface.

3. Method according to claim 1, further comprising the step of loading and modifying the objects in loading stations provided by a special dealer or special provider.

4. Method according to claim 1, further comprising the step of generating and displaying, with the aid of objects, fully or in part on the display of the mobile station, a menu for value added services node.

5. Method according to claim 4, further comprising the step of changing, adjusting, or updating the menu and the display of the mobile station by means of loading a new object in dependence of the actions previously executed in the value added services node.

6. Method according to claim 1, wherein the objects are stored in an object center of the mobile communication system from where they are called up and loaded in the mobile terminal.

7. Method according to claim 1, wherein the objects are loaded into a memory of the mobile terminal in the mobile station.

8. Method according to claim 1, wherein the objects are loaded into a memory of the subscriber identity module.

9. Method according to claim 1, wherein transfer, activation, modification and updating the objects take place via short messages or GPRS services of the mobile communication system.

10. Method according to claim 1, wherein keys or key combinations in the mobile station are allocated via the objects to individual functions of the value added services.

11. Method according to claim 1, wherein loading and modifying the objects in the mobile station is initiated by means of selected events.

12. Method according to claim 1, wherein loading and modifying the objects in the mobile station is initiated by the subscriber.

15. Method according to claim 1, further comprising the step of allocating keys of the mobile station to actions of a value added service, said allocating based on the object containing an abbreviated form of a menu of value added services.

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X. EVIDENCE APPENDIX

No evidence is submitted herewith.

XI. RELATED PROCEEDINGS APPENDIX

No proceedings which are related to, will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal are known to the Appellant, the Appellant's representatives, or the assignee.